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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,018	09/20/2001	Joseph E. Kaminkow	0112300-581	2458

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BELL, BOYD & LLOYD LLP
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EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT	PAPER NUMBER
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3714

NOTIFICATION DATE	DELIVERY MODE
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04/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary	Application No. 09/957,018	Applicant(s) KAMINKOW, JOSEPH E.	
	Examiner William H. McCulloch	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12 and 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/11/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to a response received 12/11/2007. Claims 1-4, 6-12, and 14-25 are pending in the application.

Information Disclosure Statement

2. The information disclosure statement (IDS) with mailroom date 12/11/2007 was filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the Examiner has considered the information disclosure statement.

Double Patenting/Terminal Disclaimer

3. The Office Action mailed 9/11/2007 rejected claims 1-4, 6-12, and 14-25 under the grounds of nonstatutory obviousness-type double patenting over copending Application No. 10/327538 (now U.S. 7,303,469) and U.S. 6,511,375. Applicant submitted terminal disclaimers for each of the aforementioned patents on 1/11/2008. Such terminal disclaimers are accepted and adequate to overcome the double patenting rejections.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6, 9-12, 14, 21-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/09259 to Bennett (hereinafter Bennett).

The examiner notes that the independent claims presented have substantial (but not total) overlap in scope. The examiner has perceived the differences in the scope of the independent claims. However, in the interest of conciseness, the examiner will address the most specific elements of the independent claims. All broader limitations are addressed because they are within the scope of the below-described elements and the teachings of Bennett. Regarding claims 1, 6, 9, 14, 21, and 25, Bennett teaches the following limitations:

- A gaming device (figs. 1,6), the gaming device comprising:
- A display device (display 11);
- An input device (touch sensitive areas on the display surface, see at least the abstract)
- A processor in communication with the display device and the input device (e.g., game control processor circuits, see at least the abstract; microprocessor, see at least p.3, ll. 11-15), wherein the processor is programmed to:
- Cause a plurality of masked selections to be displayed to a player by the display device (see at least figs. 2-4; p.3, ll. 25-28; and p.4, ll. 9-12);
- Associate a plurality of different values with the masked selections prior to said masked selections being picked by the player and without displaying which values are associated with which selections (see at least figs. 2-4 and p.3, ll. 11-31);
- Enable the player to pick a plurality of said masked selections for a designated number of sets, said designated number being at least two (the examiner

interprets a “set” as a plurality of selections chosen by the player; see at least figs. 2-4 and p.3, ll. 11-31);

- Form the designated number of sets of a plurality of said values, each set determined by the player picking a plurality of said selections for said set wherein the plurality of values in each set are based on the values associated with the selections picked by the player for said set (see at least figs. 2-4 and p.3, ll. 11-31);
- Cause a display of each of the sets and the values in each set (see at least figs. 2-4);
- Generate a plurality of awards by selecting a plurality of but not all of the values in each one of said sets (selections bearing a prize are selected (e.g. 5 credits), whereas “zero prize” zones are not used to generate the award(s); see at least p.2, ll. 17-19);
- Generate a resulting award by performing at least one mathematical operation on the awards generated from the set (adding the prize bearing selections and/or multiplying them by a bet of credits; see at least figs. 2-4 and p.3, line 32-p.4, line 19);
- Provide said resulting award to the player (see at least p.4, ll. 13-19).

Claims 3-4, and 11-12 are explained above with regard to the independent claims. Regarding claims 2, 10, 22, and 24, Bennett teaches selecting at least the largest value or award of each set (see at least p.3, line 32-p.4, line 19).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 15-20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied above in view of U.S. 6,345,824 to Selitzky.

Regarding claims, 8, 15-16, 18-19, and 23 Bennett teaches the invention substantially as described above. Bennett lacks in explicitly teaching selecting “at least one but not all of” the awards from the plurality of different sets in order to generate a resulting award. Selitzky teaches a game with a bonus feature wherein if the player's hand includes more than one bonus combination, only the highest ranking bonus combination is rewarded (see at least 7:1-13). It would have been obvious to one of ordinary skill in the art at the time of invention to apply the teaching of Selitzky (only awarding the highest ranking bonus combination) to the invention of Bennett in order to allow more award bearing selections (in Bennett) to be displayed on the screen without the provision of large awards paid by the gaming establishment, resulting in more frequent but smaller value awards being paid out by the gaming machine. Such a result is favorable to a gaming establishment because it allows customers to be frequently awarded (which results in more repeat customers) without the need for the gaming establishment to pay large sums.

Bennett describes claims 17, 20, and 24, as shown with regard to claims 2, 10, 22, and 24 above. Bennett describes claim 19 with respect to claims 1, 6, 9, 14, 21, and 25 above.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied above, and further in view of Admitted Prior Art.

Regarding claim 7, Bennett lacks in explicitly teaching that the display device displays the selections and reveals values associated with the selections that are not picked by the player. The Examiner, in a previous rejection, took Official Notice that it was notoriously well known in the art at the time of invention to display the non-chosen values, in addition to the chosen values. One of ordinary skill in the art at the time of invention would have been motivated to do so in order to indicate to the player what he or she could have selected. U.S. 6,102,798 to Bennett (previously of record) shows this feature to be well known in the art. Applicant failed to adequately challenge the Examiner's Official Notice and it is now considered Admitted Prior Art.

Response to Arguments

9. Applicant's arguments filed 12/11/2008 have been fully considered but they are not persuasive.

Applicant contends on pages 18-19 of the response that Bennett does not teach features of the claims directed toward generating at least one award by selecting at least one but not all of the plurality of values in each one of the sets. Applicant argues that Bennett's slot machine selects all of the player's selections because "the player accumulates prizes for each square selected," citing Bennett page 2, lines 28 to 29.

Applicant acknowledges that Bennett teaches a number of zero-prize selections, but concludes that a player of Bennett receives a prize composed of the sum of the selections (including zero-prize selections) and states that Bennett's invention is therefore different from the claimed award composed of at least one but not all selected values.

The Examiner submits that Bennett's invention, though described in different terms, anticipates the claimed invention. Let us consider two numerical examples to prove that Bennett is the same as the claimed invention. First, consider a situation where the player makes four selections in the claimed invention and Bennett's invention, where one of the selections in Bennett is a zero-prize selection. In the claimed invention, the player would receive an award comprised of three of the four selections. In Bennett, the player would receive an award of four selections, one of the selections being 0, which is the same as a prize of three selections. Making use of the identity property for addition, we see that any number plus zero is equal to that number. So, for a selection of 3+4+5+0 credits in Bennett, the player is given $12+0=12$ credits. Given that the remaining three selections in the claimed invention are also 3, 4, and 5, the outcome is the same at 12 credits.

As a second example, say a player selects three values in both the claimed invention and Bennett's invention, the values of said selections being 5, 5, and 0 credits. In Bennett's invention, the player clearly receives $5+5=10$ credits and, based on Applicant's reading of the reference, "receives" 0 additional credits, for a total award of 10 credits. Given the same situation in the claimed invention, the player may receive

5+5=10 credits and, based on Applicant's interpretation, the player does not "receive" 0 credits, for a total award of 10 credits. The Examiner submits that these situations are exactly the same, not only because the inputs of the system (5, 5, and 0 credits) and the outputs of the system (10 credits) are identical, but also because "receiving" 0 credits is exactly the same as "not receiving" 0 credits.

For at least these reasons, the claimed invention fails to show patentability over Bennett. Even if it could be shown that the claimed invention were somehow different from Bennett (a point in no way conceded by the Examiner), there is nothing inventive about providing the player with a plurality of but less than all award values. Certainly, there are countless examples of providing a player exactly one prize value as an award (Selitzky being one). Bennett clearly shows providing the player a plurality of award values. Finally, Selitzky clearly demonstrates discriminating an award value from a plurality of award values that could be awarded to the player. Considering only the prior art of record, at best it is an obvious matter of design choice to provide a plurality but less than all prize values to the player. Of course, such reasoning is purely academic because, as described above, Bennett anticipates the pertinent claims of the invention.

Applicant argues that the rejection of claims over Bennett in view of Selitzky and Bennett in view of Official Notice (now Admitted Prior Art) using the same reasoning as arguments to which the Examiner has responded above. Applicant also asserts that the combination of Bennett and Selitzky or Admitted Prior Art employs impermissible hindsight reconstruction, but proffers no evidence or reasoning of such. For these additional reasons, the claimed invention fails to show patentability over the prior art.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
3/26/2008

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714